

O/0769/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004062250

BY WOLF EMOBILITY GMBH

TO REGISTER THE TRADE MARK:

WOLF eMobility

IN CLASSES 9, 11, 12, 35, 36, 37, 39, 41, 42 AND 45

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 451135

BY VOLKSWAGEN AKTIENGESELLSCHAFT

BACKGROUND AND PLEADINGS

1. On 11 June 2024, WOLF eMobility GmbH (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the United Kingdom. The application was published for opposition purposes on 30 August 2024 and registration is sought for the goods and services set out below:

Batteries, electric, for two-wheeled electric cabin scooters; Battery chargers for two-wheeled electric cabin scooters; Chargers for electric batteries for two-wheeled electric cabin scooters; Charging stations for two-wheeled electric cabin scooters.
(Class 9)

Headlights for two-wheeled electric cabin scooters. (Class 11)

Electric vehicles, namely two-wheeled electric cabin scooters; Mobility scooters, namely two-wheeled electric cabin scooters; Automobile chassis for two-wheeled electric cabin scooters; Brakes for two-wheeled electric cabin scooters; wheels for two-wheeled electric cabin scooters; Bodies for two-wheeled electric cabin scooters; Windows for two-wheeled electric cabin scooters; Seats for two-wheeled electric cabin scooters; Doors for two-wheeled electric cabin scooters; Undercarriages for two-wheeled electric cabin scooters; Hoods [folding roofs] for two-wheeled electric cabin scooters; Trolleys; all the aforementioned goods not in relation to bicycles.
(Class 12)

Commercial administration of the licensing of the goods and services of others; Marketing; Market intelligence services; Marketing research; Market studies; Public relations services; Targeted marketing; Negotiation and conclusion of commercial transactions for third parties; Business brokerage services; all the aforesaid services provided in connection with two-wheeled electric cabin scooters. (Class 35)

Brokerage of carbon credits; Hire-purchase financing for two-wheeled electric cabin scooters; Lease purchase financing of two-wheeled electric cabin scooters. (Class 36)

Service stations [re-charging and maintenance]; Custom installation of exterior, interior and mechanical parts for two-wheeled electric cabin scooters [tuning]; Two-wheeled electric cabin scooters maintenance and repair. (Class 37)

Passenger transport; Transport of travellers; Transport services for sightseeing tours; Traffic information; Booking of seats for travel; Two-wheeled electric cabin scooters sharing services; Chauffeur services for two-wheeled electric cabin scooters; Forwarding services; Haulage; Two-wheeled electric cabin scooters subscription services; Transport reservation for two-wheeled electric cabin scooters; Transport by two-wheeled electric cabin scooters; Transportation logistics for two-wheeled electric cabin scooters; Two-wheeled electric cabin scooters rental; Two-wheeled electric cabin scooters hire services; Garage rental for two-wheeled electric cabin scooters; Providing customized driving directions for two-wheeled electric cabin scooters; Providing information relating to two-wheeled electric cabin scooters services. (Class 39)

Advanced driving instruction for drivers of two-wheeled electric cabin scooters; Arranging competitions and tournaments relating to driving two-wheeled electric cabin scooters; Commercial vehicle driving instruction for two-wheeled electric cabin scooters; Driving instruction for two-wheeled electric cabin scooters; Racing information services for two-wheeled electric cabin scooters; Organising of racing competitions for two-wheeled electric cabin scooters; Organisation of racing events for two-wheeled electric cabin scooters; Organisation of races for two-wheeled electric cabin scooters. (Class 41)

Providing scientific information, advice and consultancy relating to net zero emissions; Provision of scientific information, advice and consultancy in relation to carbon offsetting; Engineering services; Electronic data storage; Mechanical research; Research and development of new products for others; Industrial design; Construction drafting; Technological consultancy; Technological research; Vehicle roadworthiness testing; Scientific research; Scientific research in the field of environmental protection; all the aforesaid services provided in connection with two-wheeled electric cabin scooters. (Class 42)

Copyright management in connection with two-wheeled electric cabin scooters. (Class 45)

2. On 3 December 2024, the application was opposed in its entirety by Volkswagen Aktiengesellschaft (“the opponent”) under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). For the purpose of its objection under sections 5(2)(b) and 5(3) of the Act, the opponent relies upon the following trade mark and all

goods and services for which it is registered:

UKTM no. 900751909¹

Golf

Filing date: 19 February 1998

Registration date: 14 April 1999

Seniority date: 14 November 1973 (UK TM no. 1020695)

Industrial oils and greases; fuel (including motor spirit). (Class 4)

Motors, other than for land vehicles; machine coupling and transmission components (except for land vehicles); agricultural devices. (Class 7)

Vehicles (except golf carts); parts of vehicles; apparatus for locomotion by land, air or water. (Class 12)

Carpets, door mats (including carpets for automobiles); mats and other floor covering. (Class 27)

Toys cars, scale model vehicles. (Class 28)

Repair, especially repair and maintenance of vehicles. (Class 37)

(“the opponent’s mark”)

3. Under section 5(2)(b), the opponent claims that the similarity between the marks’ respective “Golf” and “Wolf” elements, and the identity and/or similarity between the parties’ terms, gives rise to a likelihood of confusion, which includes a likelihood of association.

4. Under section 5(3) of the Act, the opponent claims that its earlier mark enjoys a reputation in respect of the goods and services listed above. The opponent claims that

¹ The opponent’s mark is a comparable mark deriving from an EUTM. On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UKIPO created comparable UK trade marks for all rights holders with existing EUTMs. As a result, the marks were automatically converted to comparable UK trade mark. Comparable UK marks are now recorded on the UK trade marks register, have the same legal effect as if they had been applied for and registered under UK law, and the original filing dates remain the same.

use of the applicant's mark would, without due cause, take unfair advantage of, and/or be detrimental to, the distinctive character or reputation of the earlier mark.

5. Under section 5(4)(a) of the Act, the opponent relies upon the sign **GOLF**, which it claims to have used throughout the UK since 1974 in relation to *vehicles* and *parts and accessories for vehicles*. The opponent claims to have accrued a "considerable goodwill" in respect of the same, and submits that use of the applicant's mark would amount to passing off.

6. The applicant filed a counterstatement in which it denied the claims set out above and put the opponent to proof of use of its mark in respect of all goods and services relied upon.

7. The opponent is represented by WP Thompson and the applicant by Tomkins & Co. Both parties filed evidence during the course of the proceedings. Neither party requested a hearing, though the opponent elected to file submissions in lieu. This decision is taken following a careful perusal of the papers.

Evidence and submissions

8. The opponent filed evidence in the form of two witness statements from Mr Gavin Hyde-Blake² alongside accompanying exhibits GHB1 to GHB11 and GHB12, a witness statement from Mr Francesco Simone³ alongside exhibits FS1 to FS3 and, finally, a witness statement from Mr Rod McLeod⁴ alongside exhibits VW1 and VW2.

9. The applicant's evidence took the form of two witness statements accompanied by a total of three exhibits. The first witness statement comes from Mr Wolfgang Podleiszek⁵, supported by exhibit WP, and the second comes from Mr Ute Von Wietersheim⁶, supported by Exhibits 1-2. The applicant filed written submissions alongside.

² Dated 4 July 2025 and 16 April 2025

³ Dated 15 April 2025

⁴ Dated 12 May 2025

⁵ Dated 6 October 2025

⁶ Dated 6 November 2025 (Translator)

10. The opponent filed written submissions in lieu of a hearing on 2 March 2026.

RELEVANCE OF EU LAW

11. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

Section 5(2)(b)

12. Section 5(2)(b) of the Act reads as follows:

“5(2) A trade mark shall not be registered if because –

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

13. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

14. The opponent's mark clearly qualifies as an earlier mark pursuant to section 6 of the Act. Having been registered for more than 5 years before the application date of the mark at issue, the mark is subject to the proof of use provisions laid out in section 6A of the Act.

Proof of use

15. Although the opponent has been put to proof of its mark, I do not consider that the issue of use will be determinative in these proceedings for reasons that will later become apparent. Consequently, I will conduct my assessment on the basis that the opponent can rely upon the full breadth of its specification.

Section 5(2)(b) – case law

16. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*.⁷

a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

b) the matter must be judged through the eyes of the average consumer of the goods or services in question. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind, and whose attention varies according to the category of goods or services in question;

c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

d) the visual, aural and conceptual similarities of the marks must normally be

⁷ [2025] UKSC 25

assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks and vice versa;

h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; and

k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

17. The parties' goods and services are set out respectively at paragraphs 1 and 2 of this decision.

18. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. This includes their nature, intended purpose and method of use and whether they are in competition with each other or are complementary⁸.

19. As for when goods (or services) can be considered identical, in *Gérard Meric v Office for Harmonisation in the Internal Market*,⁹ the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

20. In its written submissions, whilst in the main the applicant submits that its “highly specialized and specific” products are dissimilar to those relied upon by the opponent, it acknowledges that “there may be certain overlaps and instances of similarity due to the broad use of the class 12 terms “vehicles (except golf carts); parts of vehicles; apparatus for locomotion by land, air or water” within the Opponent’s registered specification.” Its primary position appears to be that the opponent has not shown genuine use of its mark to an extent that it may rely on such broad terms.

21. The opponent’s position is that all of the parties’ goods and services are identical or similar to some degree, and it has provided several tables in its written submissions setting out various reasons to support a finding of similarity. I do not intend to reproduce the content of those tables here, but have taken the opponent’s reasoning into account.

22. Applying the guidance set out above in *Merici*, I find the applicant’s *electric vehicles, namely two-wheeled electric cabin scooters* is encompassed by, and therefore identical to, the opponent’s broader term *vehicles (except golf carts)*. Further, I find a number of the class 12 terms in the applicant’s specification are encompassed by the

⁸ *Canon*, Case C-39/97

⁹ Case T- 133/05

opponent's *parts of vehicles (windows or brakes for two-wheeled electric cabin scooters, for example)*. These are also identical.

23. In class 37, I consider the applicant's *two-wheeled electric cabin scooters maintenance and repair* identical to the opponent's services which are proper to the same class (*Repair, especially repair and maintenance of vehicles*).

24. I will proceed on the basis that at least some of the parties' terms are identical.

The average consumer and the nature of the purchasing act

25. In *Iconix Luxembourg Holdings*, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor*,¹⁰ where he pointed out that:

"16. First, the average consumer is both a legal construct and a normative benchmark. They are a legal construct in that consumers who are ill- informed or careless and consumers with specialised knowledge or who are excessively careful are excluded from consideration. They are a normative benchmark in that they provide a standard which enables the courts to strike a balance between the various competing interests involved, including the interests of trade mark owners, their competitors and customers.

17. Secondly, the average consumer is neither a single hypothetical person nor some form of mathematical average, nor does assessment from the perspective of the average consumer involve a statistical test. They represent consumers who have a spectrum of attributes such as gender, age, ethnicity and social group. ... It follows that assessment from the perspective of the average consumer does not involve the imposition of a single meaning rule akin to that applied in defamation law (but not malicious falsehood). ... if having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, then a finding of infringement may properly be made.

¹⁰ (Rev1) [2024] EWCA Civ 262

18. Thirdly, assessing from the perspective of the average consumer is designed to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence. ...

19. Fourthly, the average consumer's level of attention varies according to the category of goods or services in question.

20. Fifthly, the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind."

26. The average consumer of the goods and services at issue is predominantly a member of the general public, of an appropriate legal age. The purchase is unlikely to be made on a particularly frequent basis and the associated cost can vary quite considerably. The consumer is likely to be alive to considerations such as affordability, features and the reputation of the provider when approaching its purchase. Where the goods concerned are to aid the user's mobility, compatibility would also be a likely consideration. The goods and services are, to my knowledge, mostly selected from the pages of a specialist catalogue or an online resource, or from physical premises such as a showroom or workshop, for example. Consequently, the marks' visual impression is likely to carry the greatest weight, though I do not discount the relevance of the aural impression as recommendations may be made by peers or industry professionals, for example. Weighing all considerations, I find the level of attention likely to be applied will typically be of at least a fairly high degree.

Comparison of trade marks

27. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and

conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*¹¹, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

28. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

29. The parties’ trade marks are shown in the table below:

Opponent’s mark	Applicant’s mark
Golf	WOLF eMobility

Overall Impression

30. The opponent’s mark comprises a single word only. Absent of any further components, the mark’s overall impression therefore lies solely in GOLF.

31. The applicant’s mark is word-only, comprising two words of four letters and nine letters respectively. The mark’s first word, WOLF, is presented in upper case, whilst in the mark’s second word, “eMobility”, only the second letter is capitalised. Given the

¹¹ Case C-591/12P

nature of the words themselves, the mark's first word, WOLF, is likely to play a greater role in terms of an overall impression, with "eMobility" likely to be perceived as a nod toward the nature of the relevant goods and services and therefore carrying a lesser weight.

32. Visually, the marks share a letter sequence in O-L-F. These are the latter three letters of four in the sole word element of the opponent's mark (preceded only by a G) and the latter three letters of four in the first word element of the applicant's mark (preceded by a W). The second word in the applicant's mark has no counterpart in the opponent's mark. In light of my findings concerning the marks' overall impressions, and having due regard to the rule of thumb concerning the beginnings of marks which are generally more impactful¹², I find the marks' visual similarity is of a low degree.

33. Aurally, the opponent's mark will be articulated in its usual way, in one syllable: "GOLF". As for the applicant's mark, it will likely comprise six syllables, loosely "WOOLF/EE/MO/BIL/IT/EE". Other than some degree of similarity between the marks' respective GOLF/WOLF elements (particularly the sound created by the shared "L-F" at the end of the words), the marks are aurally distinct, and of notably different lengths. I find any aural similarity between the marks would be of a very low degree only.

34. The marks' conceptual impressions must be considered from the perspective of the average consumer. I will briefly summarise the parties' positions on the matter. In its submissions, the applicant attributes distinct meanings to the respective marks, leading it to conclude that "the signs are to be considered conceptually dissimilar to one another". The opponent, in turn, contends that "...the earlier trade mark could be perceived as a term of fantasy or a reference to the game of golf. The applied-for mark could be perceived as a term of fantasy or a reference to the animal wolf. For some consumers, the conceptual element would therefore be neutral, while others would perceive conceptual differences."

35. To my mind, conceptually, the opponent's mark will naturally be perceived as an ordinary word which describes a popular sport. In the applicant's mark, WOLF is a dictionary word which will retain its ordinary meaning, being a wild predatory animal.

¹² *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

The mark's second word element, eMobility, is likely to be seen as an indication that the products available under the mark are designed to aid mobility to some extent, with the 'e' at the beginning of the word suggesting that the products are electrically-powered. Each word retains its own respective meaning, though, as already indicated, it is WOLF which will carry the greatest conceptual weight. I do not consider there to be any conceptual similarity between the parties' marks.

The distinctive character of the earlier trade mark

36. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*¹³, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

37. Registered trade marks possess varying degrees of inherent distinctive character,

¹³ Case C-342/97

ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

38. I will begin by assessing the inherent distinctiveness of the opponent's mark. As already noted, the mark comprises an ordinary dictionary word with which the average consumer will be entirely familiar. As for its concept, to my mind the mark cannot be considered descriptive or allusive when viewed in respect of the relied-upon goods or services. Still, it is nonetheless a fairly short, dictionary word. On balance, I find the mark's inherent distinctiveness is between a low and medium degree.

39. I now turn to consider whether the distinctiveness of the opponent's mark has been enhanced by virtue of its use. For such purposes, it is use in the UK which is relevant. With that in mind, I note the following from the opponent's evidence:

- The opponent's GOLF vehicles were launched in the UK in 1974.
- Sales and turnover of the opponent's GOLF vehicles resulting from UK showroom visits between June 2019 and May 2024 were as follows¹⁴:

Year	AaH Volume	Turnover	Total Terms	Turnover - Total Terms
2019 (Jun-Dec)	28,598	655,952,090	185,313,995	470,638,095
2020	39,116	896,116,274	244,814,543	651,301,731
2021	26,714	673,578,653	152,789,853	520,788,800
2022	24,469	606,625,154	124,605,093	482,020,062
2023	24,796	683,637,609	146,614,714	537,022,895
2024 (Jan-May)	14,431	413,148,497	104,625,343	308,523,155

- As for the total number of GOLF vehicles sold in the UK, between June and December 2019 this stood at 31,167; in 2020 44,406 vehicles were sold; in 2021, 30,255 were sold; in 2022, 26,558 were sold; in 2023, 28,545 were sold and between January and June 2024, 19,036 GOLF models were sold.
- The turnover of Volkswagen Authorised Repairers for parts for Golf vehicles was over £19million in 2023 and over £20million in 2024.
- The Golf has been awarded a number of awards including, for example,

¹⁴ Given that the turnover concerns UK showroom visits specifically, I find it reasonable to infer that the turnover is expressed in GBP.

Company Car and Van's "Medium Car of the Year" and Autocar's "Readers' Champion Award" in 2021.

- In 2021 and 2022, the GOLF was amongst the top 10 best-selling car models in the UK.
- An array of articles in evidence from UK publications describe the opponent's GOLF as "iconic". In December 2019, an article from Mailonline headed "Is the new VW Golf the best yet?" states that "it's now more than 4 years since the first boxy Volkswagen Golf hit the road... Since then, 35 million have been built making the hatchback a household name for generations. ...The Golf is the perennial family hatch and is consistently among the most-bought C-segment cars in the UK and across Europe."

40. Having taken all of the evidence into account, including the highlights set out above, I am satisfied that the distinctiveness of the opponent's mark has been enhanced through use to at least a fairly high degree in relation to (at least) vehicles and parts of vehicles.

Likelihood of confusion

41. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion. Conversely, the less distinctive it is, the lower the likelihood of confusion.

42. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and the respective goods and/or services down to the responsible undertakings being the same or related.

43. Throughout the course of my decision I found the parties' marks visually similar to a low degree, aurally similar to a very low degree and conceptually dissimilar. At least

some of the competing goods and services are identical. The average consumer is a member of the general public of legal driving age. The marks' visual impression is likely to carry the greatest weight during the purchasing process (though I do not overlook the significance of the marks' aural impact), with the consumer likely to apply at least a fairly high degree of attention. The opponent's mark is inherently distinctive to between a low and medium degree, though its distinctiveness has been enhanced through use to at least a fairly high degree.

44. I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*,¹⁵ where he explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

¹⁵ Case BL O/375/10

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

45. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,¹⁶ Arnold LJ approved Mr Purvis's formulation but added:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

46. In *The Picasso Estate v OHIM*,¹⁷ the CJEU found that:

"20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law."

47. In *Nokia Oyj v OHIM*,¹⁸ the GC stated that:

"Furthermore, it must be recalled that, in this case, although there is a real

¹⁶ [2021] EWCA Civ 1207

¹⁷ Case C-361/04 P

¹⁸ Case T-460/07

conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

48. I begin with direct confusion. Notwithstanding the enhanced distinctiveness enjoyed by the opponent’s mark, to my mind, the marks are simply not sufficiently similar for the consumer to feasibly mistake one mark for the other. Regardless of whether the purchase is approached on visual or aural terms, the differences between the marks are such that the consumer will be able to readily distinguish one from the other. Further, the conceptual impressions evoked by the respective marks are completely disparate. Even in circumstances whereby the marks are used in respect of identical or highly similar goods or services, I dismiss a likelihood of direct confusion. It follows that there is even less opportunity for direct confusion to arise when considered in respect of goods or services which are similar to a lesser degree.

49. Having identified that the marks are clearly not the same, I can see no reasonable basis on which to find that the average consumer would attribute the similarities between the marks to a shared or related undertaking. The only similarity between the marks is the series of letters O-L-F (residing in GOLF in the opponent’s mark and WOLF in the applicant’s mark). A similarity of this nature, to my mind, is much more likely to be attributed to mere coincidence than it would to a related economical undertaking. The differences between the marks are not consistent with what the consumer will be inclined to perceive as a brand extension or sub-brand. I have taken into account the enhanced distinctiveness of the opponent’s mark and the relationship between the goods and services at issue. Whilst I do not overlook the potential effects of the interdependency principle, I can see no justification to support a likelihood of indirect confusion. This finding extends from identical goods or services to those which share a lesser degree of similarity.

50. The opposition based upon section 5(2)(b) fails.

Section 5(3)

51. Section 5(3) of the Act states:

“5(3) A trade mark which –

a. is identical with or similar to an earlier trade mark, [...] shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

52. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*, Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26. 46

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish

the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

53. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

54. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks are similar. Secondly, the opponent must show that its mark has achieved a level of knowledge/reputation amongst a significant part of the public throughout the relevant territory. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods or services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

55. I can deal with this ground relatively swiftly. I am satisfied on the basis of the evidence before me that the opponent (and its mark) enjoys a strong reputation in the UK for (at least) vehicles and parts thereof, and that it did so at the relevant date of 11 June 2024. It is clear that the opponent at large is highly regarded in the automobile market and there are several instances in evidence of its Golf models in particular being said to enjoy “iconic” or “cult” status amongst UK drivers. The Golf is clearly a popular car, with articles applauding its technology and comfort (for example), alongside other features. Such recognition is reflected in the variety of awards the Golf has received in recent years and its consistent presence amongst the top 10 best-selling UK car models. The turnover and number of sales enjoyed by the opponent solidifies its position. Having been awarded the Readers' Champion Award by Autocar¹⁹, the editor noted that “The Golf was the clear winner... a car that offers comfort, refinement and practicality – while still being fun to drive. ...the Golf sits perfectly balanced in the very centre of the UK car market.”

56. I now turn to consider whether the average consumer will make a link between the

¹⁹ 2021

parties' marks. My assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are *the degree of similarity between the conflicting marks; the nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public; the strength of the earlier mark's reputation; the degree of the earlier mark's distinctive character, whether inherent or acquired through use and whether there is a likelihood of confusion.*

57. I acknowledge that, compared to that which is necessary to create a likelihood of confusion, a lesser degree of similarity between the marks may be sufficient to cause the public to make a link between them under the present ground. Still, notwithstanding the strength of the opponent's reputation and distinctive character of the mark it relies upon, nor the closeness between the parties' goods and services, due to the low (if not tenuous) similarity between the parties' marks, I can see no circumstances under which the relevant public would be inclined to make a link between them. The marks evoke completely disparate concepts and are sufficiently distinct to overcome such a risk and, as such, no damage can be made out.

58. The opposition based upon section 5(3) of the Act is dismissed.

Section 5(4)(a)

59. Section 5(4)(a) of the Act states as follows:

"5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this

Act as the proprietor of “an earlier right” in relation to the trade mark”.

60. In *Discount Outlet v Feel Good UK*²⁰, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

61. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other indicium which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles

²⁰ [2017] EWHC 1400 IPEC

which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

Relevant date

62. For the purpose of the present assessment, the relevant date is the filing date of the applicant’s mark: 11 June 2024.²¹

Goodwill

63. Goodwill was described in *Inland Revenue Commissioners v Muller & Co’s*

²¹ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11

*Margarine Ltd*²² in the following terms:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

64. Again, I find I can deal with this ground relatively swiftly. I am in no doubt that the opponent enjoys a significant goodwill for (at least) vehicles and parts of vehicles, and that the sign GOLF was distinctive of that goodwill at the relevant date. However, with the sign relied-upon being identical to its earlier mark, the opponent faces the same difficulty here as it has under the previous grounds. Whilst I accept that the test for misrepresentation is different from that for a likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”, it has been acknowledged that they are unlikely to produce different outcomes in practice²³. I have found only a low or very low degree of visual and aural similarity between the opponent’s GOLF mark and the mark for which the applicant seeks registration and found that the marks respectively convey entirely dissimilar concepts. To my mind, notwithstanding the degree of goodwill the opponent has exhibited, and the closeness (and sometimes identity) between the terms relied upon and those in the applicant’s specification, the considerable distance between the opponent’s sign and the applied-for mark, particularly conceptually, overcomes any opportunity for misrepresentation to arise.

65. The opposition based upon section 5(4)(a) of the Act is therefore dismissed.

CONCLUSION

66. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

²² [1901] AC 217 (HOL)

²³ *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41

67. The applicant has been successful and is entitled to a contribution towards its costs in accordance with the scale published in Tribunal Practice Notice 1 of 2023. Applying the guidance set out therein, I award the applicant costs as follows:

Considering the Notice of Opposition and preparing a counterstatement:	£350
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Considering the opponent's evidence and preparing evidence in reply:	£850
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Total:	£1200
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68. I hereby order Volkswagen Aktiengesellschaft to pay WOLF eMobility GmbH the sum of £1200. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 24th day of August 2026

Laura Stephens
For the Registrar